

## REMARKS

### I. Rejections under 35 USC §102

Claims 12-15, 18, 21-27, 29, 30 and 32 remain rejected under 35 USC §102(a) as allegedly being anticipated by Kimura et al. (Kimura), U.S. Pat. No. 5,690,916. The rejection is maintained for reasons of record. The reasons of record, set out in the previous office action, are as follows:

Kimura discloses a foundation comprising 9.0% by weight of blue interference pigments and iron oxides, 11% by weight of titanium dioxide, and sericite, other non-interference inorganic pigments which examiner views are used to match skin tone and thus meet the "skin color" limitation.

Since claimed composition is disclosed in the prior art, examiner take the position that the claimed method of reducing wrinkles is inherently practiced by the prior art method of topically applying the same composition. Examiner takes the position that... wrinkle and lines inherently form in facial skin as a natural phenomena caused by the movement of facial muscle. See instant claim 7.

Applicants again respectfully disagree with the Examiner's position that the claimed method is inherently practiced by the prior art method of topically applying the "same composition". The Examiner's statement with respect to the analysis of composition claims 21-27 in view of Kimura that the components of the composition are used "to match skin tone" and thus meet the "skin color limitation" have no basis in the teachings in the reference. There is absolutely no disclosure in the reference that the composition is skin colored. It is, however, expressly taught in Kimura that the composition is provided for adjusting skin color so that a hyperchromic portion of the skin can become inconspicuous due to an interference action by a material in the

composition having a transmitted light component which is a complementary color to the color of the skin area to be adjusted (col. 2, lines 25-29 of Kimura). The compositions in the cited reference are not intended to cover the discoloration, but by reflecting a color complementary to the discoloration (interference effect), trick the viewer's eye into perceiving the discoloration as skin-colored.

Moreover, the reference teaches reliance on the interference effect to camouflage the discoloration. The reference specifically teaches against using a composition with a high amount of pigment, such as used in a skin colored foundation, since the high amount of pigment would "spoil the transparent feel" (col. 1, lines 59-63 of Kimura). On this basis alone, the rejection of the claims cannot be maintained.

Nevertheless, Applicants have amended composition claim 21 to specify a range of the inorganic powder as no more than about 15 wt.%, based on the total weight of the composition. Support for this amendment is found in claim 32.

It would be appreciated by those skilled in the cosmetic arts that the amount of powders, in combination with non-volatile oils, remaining on the skin after the evaporation of volatile oils from the skin, affects the refractive index of the composition on the skin, and, therefore, the visual effect perceived by a viewer of the skin to which the composition has been applied. As discussed in the paragraph common to pages 4 and 5 of the subject specification, the presence of the inorganic powder in the range now specified in claim 21 softens the transition between viewing the skin at specular

and incident angles so that the viewer perceives the full benefit of the reflectance from the interference pigment from any angle. One skilled in the art would appreciate that the relatively low amount of powders used in the claimed composition results in a composition having a non-powdery consistency prior to its application to skin. It is considered that controlling the amount of the powders in the composition aids in providing the desired effect.

On the other hand, a careful review of example 13 in col. 28 of the reference (which example was specifically called to the Applicant's attention by the Examiner in paragraph 8 of the first office action, mailed February 13, 2001), which is directed to a powdery foundation, reveals a composition for camouflaging a red skin discoloration containing interference pigment, metal oxide pigments, and 58.8 wt.% inorganic powders (20.0 wt.% talc and 38.8 wt.% sericite). The claimed compositions, which contain no more than about 15 wt.% inorganic powders, would, upon application to the skin and evaporation of volatile oils, leave a substantially lower ratio of powders to non-volatile oils on the skin. Such a formulation provides the desired blurring effect without conferring an undesirable opacity to the skin to which the composition is applied. The result is a sheer natural appearance in which the blue reflectance is manifested to the degree desired to reduce the appearance of lines and wrinkles on the skin.

In view of the substantial difference between the claimed and the reference compositions, the Examiner cannot maintain a position that the reference composition is

the same as the claimed composition and that the reference composition must produce color that is the same as the claimed composition, i.e. skin colored.

Turning now to method claims 12-15 and 18, Applicants again reject the Examiner's analysis of these claims as drawn to a method inherently practiced by the prior art by topical application of the prior art composition to the skin.

Applicants repeat that the method step of applying the composition to age-wrinkled skin, a principal element of claim 12, is absent from the reference. The reference teaches only camouflaging discolorations of the skin. For this reason alone, the reference cannot anticipate the claims and the rejection should be withdrawn.

Applicants again direct the Examiner's attention to the standard of inherency set out in *Hughes Aircraft Co. v. United States*, 8 USPQ 2d 1580 (Ct Cls 1988): "...a finding of inherency requires that the intended result must undeniably and irrefutably flow from the prior disclosure". Moreover, as stated in *Continental Can Co. v. Monsanto*, 20 USPQ 2d 1746 at 1749: "To serve as anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." The Examiner has merely relied on personal opinion and has provided no such extrinsic evidence as proof that one skilled in the art would expect that applying the Kimura composition to discolored skin would necessarily

result in its application to age-wrinkled skin. That the step of applying Kimura's composition to discolored skin might possibly also involve the application of the composition to age-wrinkled skin also is not adequate to support a rejection based on anticipation by inherency. The court in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 US 45, 66 (1923) held that accidental occurrences of the claimed subject matter, not intended and not appreciated, does not constitute anticipation.

In the absence of any teaching in Kimura that the composition should be applied to wrinkled skin, and in the absence of any showing of the Examiner by extrinsic evidence that all skin bears wrinkles, any application of the reference composition to wrinkled skin is accidental and inadequate to support a conclusion of anticipation.

Nevertheless, claim 12 has been amended to specify a range of inorganic powder of no more than about 15% by weight of the total composition. As discussed above, with respect to claims 21-27, 29, 30 and 32, since the claimed and the reference compositions differ in their amounts of inorganic powder, and since the different amounts are considered to provide different optical effects to a viewer of skins to which the respective compositions have been applied, practicing the method of Kimura cannot be said to practice the claimed method. For this additional reason, the rejection of method claims 12-15, and 18 cannot stand.

## II. Rejections under 35 USC §103

The rejection of claims 19 and 33 has been maintained under 35 USC §103(a) as being unpatentable over Kimura as applied to claims 12-15, 18, 21-27, 29, 30 and 32, which are alleged to be anticipated by Kimura. The rejection is maintained for reasons of record. The rejection, stated in the previous office action, is as follows:

While the reference fails to disclose using less than 9% of the blue interference pigments, examiner notes that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. MPEP §2144.05. Since the general conditions of the instant claims are disclosed in Kimura, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. Lowering the concentration of an active component also is viewed economically advantageous from the perspective of a manufacturer.

Applicant's arguments in view of Kimura presented above with respect to claims 12-15, 18, 21-27, 29, 30 and 32 also are applicable here. The reference cannot in any way anticipate the present claims, since the reference does not disclose or suggest applying a composition to age-wrinkled skin nor that such application could cause a reduction in the appearance of the wrinkles. The Examiner, in rejecting claims 19 and 33 opines that it would have been obvious from the reference for the skilled person to use routine experimentation to discover a lower, workable range than the 9% of the interference pigments disclosed in Kimura. However, it is unclear to the Applicants how one skilled in the art, seeking guidance on the amount of interference pigments to use to reduce the appearance of wrinkles on age-wrinkled skin, could have carried out routine experimentation to discover a workable range for doing so when the cited reference is completely silent about wrinkles. The skilled person would never even have looked to

Kimura, which is concerned with camouflaging skin discolorations, for guidance in reducing the appearance of wrinkles.

Moreover, as discussed in the Applicant's response to the previous office action, MPEP §2144.05, mentioned by the Examiner, is not applicable here, since the claimed method and the method of the citation are not the same. The reference method deals with disguising discolorations of the skin, while the claimed method is directed to reducing the appearance of wrinkles on the skin. The reference makes no mention of wrinkles so one skilled in the art would not have been guided by the reference in determining workable ranges for this purpose. This is not the situation, as referred to in MPEP §2144.05, of optimization of a known method. For this reason alone, the rejection of the claims must be withdrawn.

Additionally, although the Examiner suggests that lowering the concentration of an active component would be expected to be economically advantageous to a manufacturer, the reference (col. 6, lines 54-57) teaches using not less than 10% by weight, and preferably not less than 25% by weight of interference pigment, based on the total powder content of the composition. Therefore, the reference teaches against reducing the amount of interference pigment. For this further reason, the rejection of the claims cannot stand.

Nevertheless, claims 12 and 21 now call for a specific range of inorganic powders, which range is well outside that disclosed by Kimura for compositions containing blue

interference pigment. As claims 12 and 21 have been shown to be nonobvious from the references, claims 19 and 33, which depend from claims 12 and 21, respectively, also are nonobvious in view of the references. The rejection of these claims must therefore be withdrawn.

The rejection of claims 1-7 and 9-11 under 35 USC § 103(a) has been maintained as allegedly being unpatentable over Kimura as applied to claims 12-15, 18, 19, 21-27, 29, 30, 32 and 33, and further in view of Hineno (U.S. Pat. No. 6,2007, 174). The rejection is maintained for the reasons of record. The reasons of record, stated in the previous office action, are as follows:

Kimura...fails to teach using the composition to visibly reduce wrinkles or lines on the skin. Examiner views that wrinkles cause by chronicle [sic] aging is a natural phenomena that is obviously present in mature users' skin. Thus, examiner takes the position that the prior art composition, when used by the users with aged skin, obviously renders the wrinkle minimizing effect which applicants claim.

Hineno teaches using a composite powder comprising interference or reflective pigments useful in covering wrinkle and improving skin color. See Examples 1 and 2; Tables 2 and 3...

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the Kimura composition as motivated by Hineno because of the expectation of successfully enhancing w[r]inkle-coverage effect and improving skin color tone.

As discussed in detail above, Kimura teaches only applying the composition to discolored skin to camouflage the discoloration. One skilled in the art reading the reference could have no expectation that applying the composition to wrinkled skin would have the effect of reducing the appearance of the wrinkles.



Hineno cannot cure the deficiencies in Kimura, since Hineno teaches only altering the color of a composition and the skin to which the composition is applied. The only disclosure of “wrinkle covering” in Hineno is in relation to a cream (example 1, including Table 2; col. 14-15) and a loose powder (example 2, including Table 3; col. 15-16), which both include a red, not a blue, interference pigment. Only example 10 in the reference employs an interference pigment having a blue reflectance, but that example is not directed to any kind of cosmetic composition and does not include all of the principal elements of the subject claims. Therefore, this rejection, too, must be withdrawn.

The rejection of claims 8, 16, 17, 20, 28, 31 and 34 under 35 USC §103(a) has been maintained as allegedly unpatentable over Kimura and Hineno as applied to claims 1-7, 9-15, 18, 19, 21-27, 29, 30, 32 and 33 as above, and further in view of Hurst (Face Powders, Poucher’s Perfumes, Cosmetics and Soaps). The rejection states:

Kimura and Hineno, discussed above, fail to teach bismuth oxychloride.

Hurst teaches that bismuth oxychloride is the first synthetic pearlescent pigment and now developed to provide an improved photosensitivity. See p. 117, 2<sup>nd</sup> full par. The reference further suggests that it is possible to formulate compositions using pearlescent pigments to provide “translucent luster, or frosted effect, to enhance the wearer’s natural complexion”. See p. 117, 5<sup>th</sup> full par.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding bismuth oxychloride as motivated by Hurst because of an expectation of successfully

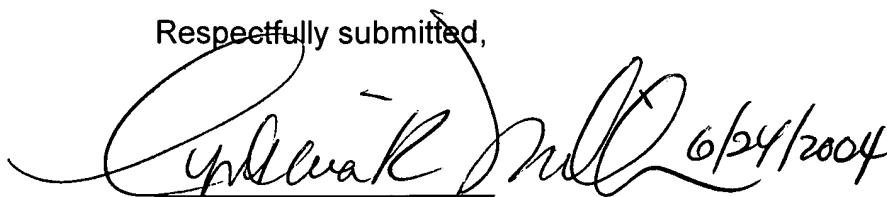
producing a composition with luster or frosted effect to enhance the natural look of the user.

As discussed above, the combination of Kimura and Hineno is inadequate to support the rejection of the claims, since the primary elements of the claims are not anticipated by or obvious from the references. In brief, Kimura does not disclose or suggest a composition comprising a blue interference pigment, a metal oxide pigment and an inorganic powder in the range of no more than about 15 wt.%, nor a method of reducing wrinkles on age-wrinkled skin by applying to the age-wrinkled skin a composition comprising a blue interference pigment, a metal oxide pigment and optionally, an inorganic powder in the range of no more than about 15 wt.%. Hineno only discloses wrinkle camouflage using a red interference pigment. Hurst merely discloses that bismuth oxychloride, a synthetic pearlescent pigment can be used in powders to add luster. Since the indicated claims depend directly from claims shown above to be unobvious in view of the references, the dependent claims also must be found unobvious, *In re Fine*, 5 USPQ 2<sup>nd</sup>, 1596 (Fed. Cir. 1988). This rejection also must be withdrawn.

## CONCLUSION

The present claims are believed to be in condition for allowance, and prompt issuance of a Notice of Allowance is respectfully solicited. The Examiner is encouraged to contact the undersigned by telephone if it is believed that discussion will resolve any outstanding issues.

Respectfully submitted,

A handwritten signature in cursive script, followed by the date 6/24/2004.

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